

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appellant	:	Lawrence F. Glaser	)	Confirmation No.: 2842
			)	
Serial No.	:	09/270,710	)	
			)	Examiner: Yehdega Retta
Filed	:	March 16, 1999	)	
			)	Art Unit: 3622
For	:	METHOD OF EMBEDDING	)	
		ADVERTISEMENTS IN	)	
		COMMUNICATION	)	
			)	Date: January 14, 2010

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

**Mail Stop AF**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Appellant hereby requests formal review of the July 14, 2009, final office action because the Examiner fails to properly consider all the claimed limitations to establish a *prima facie* case with respect to obviousness under 35 U.S.C. § 103(a).

This paper is being filed concurrently with a Notice of Appeal and the requisite fee, as required in the guidelines for the New Pre-Appeal Brief Conference Pilot Program published in the July 12, 2005, Official Gazette Notice.

Initially, Applicant wishes to remind the Examiner(s) of the filing date of the present application. Specifically, this application was filed on **March 16, 1999**. Accordingly, the Examiner(s) must place themselves in the shoes of one of ordinary skill in the art having knowledge of the state of the prior art as it was prior to March 16, 1999 and not the state of the art as it stands today. Many advances have been made in this field of technology which may give one reason to assume knowledge which was not contemplated prior to March 16, 1999; however, it is paramount that the Examiner(s) be conscious of the state of the art as it was at that time.

Claims 27, 28, 31-36 and 38-52 currently are pending, of which claims 50-52 are withdrawn by the Examiner as being drawn to a non-elected invention. Claims 27, 35, 36, 41-43 and 48 stand finally rejected under 35 U.S.C. § 103(a) as allegedly being obvious over

Apfel et al. (U.S. Patent No. 6,510,453; hereinafter, “the Apfel patent”) in view of the paper “Turning in to the Internet” by Kellee Harris (hereafter, “the Harris paper”) and further in view of Pirani et al. (U.S. Patent No. 5,105,184, hereinafter, “the Pirani patent”). This rejection is in error and should be withdrawn because the cited documents, whether considered individually or in combination, fail to teach, suggest or otherwise render obvious each and every limitation recited in independent claims 27 and 48.

More specifically, none of the Apfel patent, the Harris paper, and the Pirani patent describe the claimed combination of features including the process of embedding in an email communication “at least one pre-selected advertisement associated with the identified sending party in said communication, said embedding being done within the data processing system of the identified sending party ... wherein said advertisement is for hardware installed on the data processing system by said identified sending party,” as recited in independent claim 28, and similar features set forth in independent claim 48.

In setting forth the rejection, the Examiner first cites the Apfel patent, which is directed to a method and system for creating or inserting a signature fragment into an email (see, the abstract). More specifically, the Apfel patent describes a process that determines a context of a message created by a user (e.g., whether the message is a new message or a reply message), and thereafter determines what particular fragment to insert into the signature section of the email based on the determined context. The Examiner correctly acknowledges, at the bottom of page 2, that the Apfel patent does not teach or suggest the claimed subject matter relating to embedding an advertisement into an email, and that the advertisement is for hardware installed on the data processing system by said identified sending party.

Next, the Examiner cites the Harris paper, which describes adding a one-line marketing tagline in an email signature to describe the sender’s product or service. However, the Harris paper likewise fails to describe embedding in an email an advertisement for hardware installed on the data processing system by said identified sending party.

In an attempt to address the deficiencies of Apfel and Harris, the Examiner cites the Pirani patent, which is directed to using computer software as a medium for advertisements (see, column 2, lines 1-5). The Pirani patent describes software programs generating screens that include advertisements with data and information that would normally be displayed on a screen generated by the software program (see, column 2, lines 19-22 and 30-38). The Examiner alleges that the Pirani patent “teaches advertisement for hardware installed on the data processing system of a user.” However, the Pirani patent does not describe or remotely

suggest anything with regard to a way of adding advertisement to an email communication, much less that the advertisement is for hardware installed on the data processing system by an identified sending party as claimed. Contrary to the Examiner's statement spanning pages 2 to 3 of the final Office Action that "Pirani teaches advertisement for hardware installed on the data processing system of a user" the Pirani patent includes no such specific teaching.

In essence, the Examiner contends that because the Pirani patent describes integrating advertisements with software to provide funds to software manufacturers and developers, and to increase availability and decrease the cost of software, it would have been obvious to modify the email signature of Harris to meet the claimed features of independent claims 27 and 48. However, Pirani does not describe, imply or suggest in any way the claimed features relating to embedding an advertisement in an email communication initiated by a data processing system and that the embedded advertisement is for hardware installed on the data processing system by the user of that data processing system. Rather, the Pirani patent describes including advertisements within one or more displayed screens that would otherwise be generated by a software program executing on a computer (see, column 2 lines 30-38 and Fig. 1). Hence, even when considering the Pirani patent along with the Apfel patent and the Harris paper, such a combination would not have resulted in the invention as claimed in independent claims 27 and 48.

In the "Response to Arguments" section of the Action, beginning on page 5, the Examiner further states the following:

Examiner would like to point out that the claim does not recite 'automatically embedding at least one pre-selected advertisement.' The claim recites embedding at least one pre-selected advertisement, said *embedding being done with the data processing system* of the sending party." (Emphasis added by the Examiner.)

Appellant respectfully submits, however, that while an explicit literal recitation of "automatically embedding at least one pre-selected advertisement" is not present in independent claims 27 and 48, each of these claims recite that the transmitted email communication includes "the advertisement ... automatically embedded therein." Hence, contrary to the Examiner's implied contention, claims 27 and 48 recite an automatic embedding of a pre-selected advertisement in an email communication.

The Examiner proceeds to correctly acknowledge, in the paragraph spanning pages 5 to 6, that the Apfel patent, the Harris paper, and the Pirani patent all fail to teach marketing data for hardware installed on the data processing system (see, the last four lines of page 5 to

the first line of page 6). However, the Examiner's conclusion that it would have been obvious to automatically embed an advertisement "for software or hardware installed on the data processing [system]" in Harris' email signature because "Pirani teaches *advertisement for software* installed on the data processing system" (see, the last two lines of page 5, emphasis by the Examiner), and that "to advertise for a computer hardware or software that is installed in the computer since most hardware installed in the computer also require a software to interact with the hardware" (see, lines 1-3 of page 6), is not supported by the applied prior art. First, the Pirani patent does not describe any advertisement *for* software that is embedded in software. Second, software, by definition, is not hardware. Third, it would appear counter to common sense to display an advertisement for software within the same software installed (and running) on a user's computer because such a user would already possess that software. Fourth, Pirani does not contemplate claimed features relating to embedding in an email communication an advertisement for hardware installed on the data processing system by the sending party of that email communication and transmitting that email to a receiving party. These claimed features are significantly different from system described in the Pirani patent, which displays an advertisement to a user on a screen of "live software" program (see, column 1, lines 61-62 and column 2, lines 30-38). In fact, the Pirani patent explicitly differentiates itself from a system involving an exchange of information, and thus appears to actually *teach away* from claimed features relating to embedding an advertisement in an email communication (see, column 1, lines 50-53 and 59-62). For all these reasons, the Pirani patent fails to remedy the acknowledged shortcomings of the Apfel patent and the Harris paper.

The final Office Action also includes a rejection under 35 U.S.C. § 103(a) of dependent claims 28, 31-34, 38-40, 44-46, as allegedly being obvious over the Apfel patent, the Harris paper, and the Pirani patent in view of Markowitz (U.S. Patent No. 5,513,254, hereinafter "the Markowitz patent"). However, the description in the Markowitz patent of a method that involves a third party fax server adding an advertisement to a facsimile transmission (which is not an email), where the advertisement is chosen by the fax server based on phone number of the sender or recipient, does not make up for the deficiencies described above with respect to the Pirani patent, the Apfel patent, and the Harris paper.

Section 2143.03 of the MPEP requires the "consideration" of every claim feature in an obviousness determination. To render claims 27 and 48 unpatentable, however, the Office must do more than merely "consider" each and every feature for these claims. Instead, the

asserted combination of the Apfel patent, the Harris paper, and the Pirani patent must also teach or suggest *each and every claim feature*. See, *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (emphasis added) (to establish *prima facie* obviousness of a claimed invention, all the claim features must be taught or suggested by the prior art). Further, the necessary presence of all claim features is axiomatic, since the Supreme Court has long held that obviousness is a question of law based on underlying factual inquiries, including ... ascertaining the differences between *the claimed invention* and the prior art. *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) (emphasis added). Finally, Appellants respectfully direct attention to MPEP § 2143, the instructions of which buttress the conclusion that obviousness requires at least a suggestion of all of the features of a claim, since the Supreme Court in *KSR Int'l v. Teleflex Inc.* stated that “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (*quoting In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

In sum, it remains well-settled law that obviousness requires at least a suggestion of all of the features in a claim. See *In re Wada and Murphy, citing CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) and *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)).

For all the foregoing reasons, and those presented in the arguments submitted in Appellant's response of March 20, 2009, which are incorporated herein by reference, withdrawal of all the pending rejections of the claims and allowance of this application is earnestly solicited.

Further, while no fees are believed to be due, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-4525.

Respectfully submitted,

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